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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT C. FRAME

Appeal No. 2003-1222
Application No. 09/096,684

ON BRIEF

Before LEVY, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-55, which are all the claims in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

BACKGROUND

The invention is directed to a portable computer system whereby a user interface module communicates with a base computer. Claim 1 is reproduced below.

1. A portable computer system, comprising:

a portable base computer comprising:

a first wireless receiver,

a processor having a data input operatively connected to the first wireless receiver, and

a first wireless transmitter operatively connected to the processor, and

a processor-less portable user interface module being detachably coupleable to the portable base computer, the portable user interface module comprising:

a second wireless receiver,

a two-dimensional display having a data input operatively connected to the second wireless receiver of the portable user interface module,

a user input device, and

a second wireless transmitter operatively connected to the user input device.

The examiner relies on the following references:

Martin et al. (Martin)	5,148,155	Sep. 15, 1992
Goodrich et al. (Goodrich)	5,375,076	Dec. 20, 1994
Kikinis et al. (Kikinis)	5,522,089	May 28, 1996
Swafford, Jr. et al. (Swafford)	5,608,449	Mar. 4, 1997

Claims 1-6, 8-24, and 26-55 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kikinis, Goodrich, and Swafford.

Claims 7 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kikinis, Goodrich, and Martin.

We refer to the Final Rejection (Paper No. 16) and the Examiner's Answer (Paper No. 21) for a statement of the examiner's position and to the Brief (Paper No. 20) and the Reply Brief (Paper No. 22) for appellant's position with respect to the claims which stand rejected.

OPINION

Section 103 rejection

We cannot sustain the rejections under 35 U.S.C. § 103, for the reasons advanced by appellant in the briefs. The rejections rely on an improper combination of teachings from Kikinis and Swafford in attempting to meet all the limitations of at least the independent claims.[1] Goodrich is relied upon for a teaching related to a "battery." (Answer at 3.)

Kikinis is directed to Personal Digital Assistant (PDA) units, as described in the reference's "background" of the invention, which are designed to have standalone processing and display capabilities, but also with the capability of linking with more

[1] Swafford is not referenced in the rejection of claims 7 and 25 (Answer at 5). This, however, represents clear error since the claims incorporate the limitations of claim 1 and 21, respectively.

powerful host units. Kikinis relates, in particular, to a µPDA device (e.g., Figs. 3 and 4), described at column 5, line 25 et seq., that is suitable for docking with a notebook computer (e.g., Fig. 5).

Swafford discloses a wireless interactive consumer video system such that the input and display unit 2 (Fig. 1) may be remotely located from video electronics unit 14 (e.g., laser disc or CD-ROM player), principally so that the electronics unit will not take up retail shelf space and the unit may be protected from damage or tampering by customers (col. 4, ll. 31-44).

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001). We agree with appellant that the rejections are deficient in showing suggestion from the prior for the proposed mixing and matching of processors, displays, and input devices in the disclosures of Kikinis and Swafford. The statement of the rejection is consistent with an improper hindsight reconstruction of the invention, in using the references to show what "can" or "could" be done. The examiner relies, in particular, on the disclosure in Kikinis that the µPDA device may function as a slave unit when docked to a host. However, a temporary change in function does not change the structure or overall use of the device, in terms of the limitations (and negative limitations) that are claimed.

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 1-12 and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claim 1, from which the other claims depend, recites a "processor-less" portable user interface module. Appellant discloses a base computer 14 having a processor 40 (Spec. at 7; Figs. 1 and 3). User interface module 12 may include (Fig. 3) modem 74, wireless receiver 64 and wireless transmitter 62, input device 60, and display primitive decoder 70.

While it is clear that base computer 14, as disclosed, or a µPDA device having a CPU, as disclosed by Kikinis, cannot be considered "processor-less," the metes and bounds of the negative limitation cannot be ascertained. The user interface module, as disclosed, may contain a modem; modulating and demodulating signals would appear to constitute a processing of the signals. The module's input device would appear to process input signals. The decoding of display signals by the module's display primitive decoder would appear to be a (primitive) form of processing of the signals.

We thus cannot determine, to a reasonable degree, what may constitute a "processor-less" portable user interface, as set forth in claim 1. The claims fail to pass muster under 35 U.S.C. § 112, second paragraph.

CONCLUSION

The rejection of claims 1-55 under 35 U.S.C. § 103 is reversed. A new rejection of claims 1-12 and 39 under 35 U.S.C. § 112, second paragraph is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED -- 37 CFR § 41.50(b)

STUART S. LEVY
Administrative Patent Judge)
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HOWARD B. BLANKENSHIP) BOARD OF PATENT
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